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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,184	08/14/2001	Scot D. Wilce	G08.002	1214
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EXAMINER LIVERSEDGE, JENNIFER L				
ART UNIT 3692		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/929,184

Applicant(s)

WILCE ET AL.

Examiner

JENNIFER LIVERSEDGE

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's amendment and request for reconsideration of application 09/929,184 filed on April 20, 2009 in response to a Supplemental Examiner's Answer.

The amendment contains previously presented claims: 17-18.

The amendment contains amended claims: 1, 3-16 and 19.

Claims 2 and 20-29 have been previously canceled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 3-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub. No. US 2002/0087534 A1 to Blackman et al. (further referred to as

Blackman), in view of Pub. No. US 2002/0188539 A1 to Axelrad et al. (further referred to as Axelrad), and further in view of Advanced Perl programming by Sriram Srinivasan in 1997 (further referred to as Perl).

Regarding claims 1, 16 and 19, Blackman discloses a processor-implemented method, apparatus and medium storing instructions adapted to be executed by a processor to perform a method for facilitating generation of an agreement document associated with a financial transaction agreement between a party and a counter-party (page 1, paragraphs 1 and 7), comprising:

A processor (page 2, paragraphs 12-13 and 38);

A storage device in communication with said processor and storing instructions adapted to be executed by said processor to (page 3, paragraphs 40-47);

Receiving in a data storage element and processing in a processor the agreement information from a user associated with the party, the agreement information including (i) a counter-party communication address (page 4, paragraph 62);

Determining an agreement scope, a document scope, and a fact set scope (page 3, paragraph 40; page 11, paragraph 244);

Generating the agreement document in accordance with the information (page 1, paragraph 7; page 3, paragraph 30; page 5, paragraphs 52 and 54);

Automatically transmitting the agreement document to the counter-party via the counter-party communication address (page 3, paragraphs 40 and 47; page 4, paragraph 62; page 10, paragraph 237).

Blackman does not disclose information about a financial product associated with the financial transaction agreement; and generating the agreement document in accordance with information about the financial product and a covered products matrix. However, Axelrad discloses information about a financial product associated with the financial transaction agreement (page 2, paragraph 29; page 3, paragraphs 32 and 38); and generating the agreement document in accordance with information about the financial product and a covered products matrix (page 3, paragraph 30; page 5, paragraphs 52 and 54). It would be obvious to one of ordinary skill in the art to modify the agreement management system for financial transactions as disclosed by Blackman to adapt the use of financial products and covered products matrix as disclosed by Axelrad. The motivation would be that offering a financial product is one type of financial transaction and Blackman contains the mechanisms for offering financial transaction agreements between parties, whereby a financial product would be one of many such possibilities of offerings.

Neither Blackman nor Axelrad disclose placing the determined agreement scope, document scope, and fact scope in a scope stack and evaluating the scope stack via an evaluation engine to produce a result in accordance with a rule. However, Perl discloses placing the determined agreement scope, document scope, and fact scope in a scope stack and evaluating the scope stack via an evaluation engine to produce a

result in accordance with a rule (page 3, lines 36-41). It would be obvious to one of ordinary skill in the art to combine the use of scope stacks as disclosed by Perl with the transaction agreement system as disclosed by Blackman and Axelrad. The motivation would be that the use of scope stacks are used to organize data related to scopes of defined fields and to use them in relation to evaluating data which has been collected and stored.

Regarding claim 3, Blackman discloses the method wherein the counter-party communication address comprises at least one of: (i) an electronic mail address, (ii) an Internet address, (iii) a uniform resource locator, and (v) a telephone number (page 4, paragraph 62).

Regarding claim 4, Blackman discloses the method further comprising automatically transmitting the agreement document via a communication address associated with the party (page 3, paragraph 47; page 4, paragraph 62; page 10, paragraph 237).

Regarding claim 5, Blackman discloses the method wherein the party is associated with a first party entity and a second party entity (page 1, paragraph 7), and further comprising:

Transmitting the agreement document via a first communication address associated with the first party entity (page 2, paragraph 38; page 3, paragraph 47; page 4, paragraph 62);

Receiving information from the first party entity (page 1, paragraph 7; page 3, paragraph 47); and

Transmitting the agreement document via a second communication address associated with the second party entity (page 2, paragraph 38; page 3, paragraph 47; page 4, paragraph 62; page 10, paragraph 237).

Regarding claim 6, Blackman discloses the method wherein the agreement document comprises at least one of: (i) a final agreement document, and (ii) an amendment to an existing agreement document (page 4, paragraphs 74-78; page 9, paragraph 220; page 10, paragraphs 231 and 236-237).

Regarding claim 7, Blackman disclose the method wherein the agreement document comprises a preliminary agreement document (page 1, paragraph 7; page 3, paragraph 47; page 11, paragraph 244).

Regarding claim 8, Blackman discloses the method wherein said transmitting comprises automatically transmitting the preliminary agreement document via the counter-party communication address associated with the counter-party (page 2, paragraph 38; page 3, paragraph 47; page 4, paragraph 62), and further comprising

receiving a revised preliminary agreement from the counter-party (page 4, paragraph 70-71 and 72-78; page 14, paragraph 287; page 15, paragraph 305).

Regarding claim 9, Blacker discloses the method further comprising reconciling the revised preliminary agreement document and the preliminary agreement document; and generating a final agreement document in accordance with said reconciliation (page 16, paragraph 331).

Regarding claim 10, Blackman discloses the method where said generating comprises automatically generating a plurality of agreement documents in accordance with the information (page 9, paragraph 220; page 10, paragraph 236).

Blackman does not disclose generating the agreement document in accordance with information about the financial product and a covered products matrix. However, Axelrad discloses generating the agreement document in accordance with information about the financial product and a covered products matrix (page 3, paragraph 30; page 5, paragraphs 52 and 54). It would be obvious to one of ordinary skill in the art to modify the agreement management system for financial transactions as disclosed by Blackman to adapt the use of information regarding financial products and covered products matrix as disclosed by Axelrad. The motivation would be that offering a financial product is one type of financial transaction and Blackman contains the mechanisms for offering financial transaction agreements between parties, whereby a financial product would be one of many such possibilities of offerings.

Regarding claim 11, Blackman discloses the method wherein the agreement information comprises at least one of: (i) an agreement type, (ii) an agreement term, and (iii) an agreement fact (page 3, paragraph 40; page 4, paragraph 53; page 9, paragraph 222).

Regarding claim 12, Blackman discloses the method wherein the agreement comprises a transaction agreement associated with at least one of: (i) a set of rights between the party and the counter-party, (ii) a legal contract, (iii) a financial instrument, and (iv) a monetary amount (abstract; page 1, paragraph 9).

Regarding claims 13 and 14, Blackman does not disclose the method wherein the financial product comprises at least one of: (i) an equity product, (ii) a stock product, (iii) an index product, (iv) a fixed income product, (v) a bond product, (vi) a bank loan product, (vii) a whole loan product, (viii) an interest rate product, (ix) a credit derivative product, (x) a commodity product, (xi) a metal product, (xii) an energy product, and (xiii) an agricultural product, and where at least one transaction instrument comprises: (i) a swap instrument, (ii) an option instrument, (iii) a buy instrument, (iv) a sell instrument, (v) a call instrument, (vi) a put instrument, (vii) a forward instrument, (viii) a pre-paid forward instrument, (ix) a spot instrument, (x) a repurchase agreement instrument, (xi) a loan instrument, (xii) a warrant instrument, and (xiii) a contract for differences instrument.

However, Axelrad discloses the method wherein the financial product comprises at least one of: (i) an equity product, (ii) a stock product, (iii) an index product, (iv) a fixed income product, (v) a bond product, (vi) a bank loan product, (vii) a whole loan product, (viii) an interest rate product, (ix) a credit derivative product, (x) a commodity product, (xi) a metal product, (xii) an energy product, and (xiii) an agricultural product, and where at least one transaction instrument comprises: (i) a swap instrument, (ii) an option instrument, (iii) a buy instrument, (iv) a sell instrument, (v) a call instrument, (vi) a put instrument, (vii) a forward instrument, (viii) a pre-paid forward instrument, (ix) a spot instrument, (x) a repurchase agreement instrument, (xi) a loan instrument, (xii) a warrant instrument, and (xiii) a contract for differences instrument (pages 1-6).

It would be obvious to one of ordinary skill in the art to combine the financial products and instruments as disclosed by Axelrad with the agreement system as disclosed by Blackman. The motivation would be that transaction agreements would include the trading of financial products and where financial instruments are to be bought, sold, traded, etc. such that the impetus for developing an agreement would be to facilitate such a transaction.

Regarding claim 15, Blackman discloses the method wherein said generating is performed via at least one of: (i) a covered product matrix information retrieved from a database, (ii) a pre-stored default transaction term, (iii) information received from a user of an agreement modeling system, (iv) information received from a satellite system, and

(v) information received from a legacy agreement system (page 1, paragraph 7; page 2, paragraph 38; page 3, paragraphs 40 and 47).

Regarding claim 17, Blackman discloses the apparatus wherein said storage device further stores an agreement information database (page 3, paragraph 40).

Regarding claim 18, Blackman discloses the apparatus further comprising a communication device coupled to said processor and adapted to communicate with at least one of: (i) a client device, (ii) an agreement modeling system controller, (iii) a satellite system, and (iv) a counter-party device (page 2, paragraph 38).

Response to Arguments

The Appellant's arguments have been considered but are not persuasive.

Appellants submit that "the Perl reference does not disclose or suggest 'determining an agreement scope, a document scope, and a fact set scope' nor 'placing the determined agreement scope, document scope, and fact set scope in a scope stack' nor does the Perl reference disclose or suggest that such a scope stack is evaluated 'via an evaluation engine to produce a result in accordance with a rule'". Appellants further argue the establishment of a prima facie case of obviousness in combining the Perl reference with the combination of Blackman and Axelrad.

First, regarding appellants' arguments regarding the Perl reference and its lack of disclosure of 'determining an agreement scope, a document scope, and a fact set scope'. Examiner points to the Final Office Action where it is cited that the primary reference, Blackman, discloses the limitation of 'determining an agreement scope, a document scope, and a fact set scope' at page 3, paragraph 40 and page 11, paragraph 244. Perl is not intended to address this limitation as it is found within the disclosure of the primary reference.

Appellants argue that Perl does not disclose 'placing the determined agreement scope, document scope, and fact set scope in a scope stack' nor where a scope stack is evaluated 'via an evaluation engine to produce a result in accordance with a rule'. Perl discloses the use of scope stacks. Scope stacks are known in the industry and field of computer technology as an evaluation method by which data elements are entered into the scope stack in order to be evaluated with a result. As quoted in the Appeal Brief from the Perl reference...

"The scope stack is used to remember positions along the save stack that correspond to different scopes..."

The preceding paragraph in the Perl reference discusses the save stack in which it is stated...

"This stack is used as a repository for storing all pieces of global information that are liable to change within a nested scope..."

Further, as additional and supplemental information, Examiner offers a quote from Computer Dictionary, 2nd edition, where a stack is defined as...

"a region of reserved memory in which programs store status data such as procedure and function call return address, passes parameters, and (sometimes) local variables. The microprocessor, the program, and the operating system can all maintain one or more separate stacks. A stack is usually a data structure organized as a LIFO (last in, first out) list so that the last data item added to the structure is the first item used."

The use of scope stacks for storing information for evaluation and processing is known in the field of computer technology, and is a mechanism used in memory management. Using a scope stack to store any data or information is within the applicability of a scope stack. And as is clear from the dictionary reference above, a microprocessor, program and operating system (evaluation engine) are used for producing a result according to rules. Placing the determined agreement scope, document scope, and fact set scope in a scope stack would be obvious to one of ordinary skill in the art as scope stacks are used "behind the scenes" in computer functioning to evaluate variables and produce a result in accordance with programming and processing rules.

In response to Applicant's argument that it would not have been obvious to modify the cited prior art reference(s) to create the claimed invention, the Courts have stated that "[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one

device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." KSR Int'l Co. v. Teleflex, Inc. 127 S. Ct. 1727, 1740, 92 USPQ2d 1385, 1396 (2007).

The 103 rejection from the Supplemental Examiner's Answer is also argued. In response to the amendments as submitted, the 101 rejection has been withdrawn. The previously issued 101 was proper and based on a Board issued remand to the examiner. Bilski provides for a two prong test in which a process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials). While Applicant is correct in that meeting either prong of the test meets the requirements of Bilski, examiner notes that the claims as previously rejected under 101 failed to meet either prong in that the claims were not tied to a machine and did not transform underlying subject matter such as an article or materials. The claims as previously presented were capable of being performed without a particular apparatus to accomplish the method steps, and further failed to identify the material being changed to a different state. Because the claims do not represent material being changed to a different state, examiner pointed particularly to the Bilski test which related to performing the method steps by being tied to a particular machine.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at 571-272-6777. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jennifer Liversedge/
Examiner, Art Unit 3692

/Kambiz Abdi/
Supervisory Patent Examiner, Art Unit 3692